

REMARKS

With this amendment, claims 1 – 5, 7 - 10, 12 – 17, 19 – 21, 23 -34, 37 – 41, 43 – 46, 48 – 53, 55 – 57 and 59 - 70 are in the application. Reconsideration is respectfully requested.

Rejection Under 35 USC § 103(b)

Claim 1

Claim 1 has been amended to include the feature of now cancelled claim 6.

The feature of claim 6 provides for the processing machine to transmit instructions to a health care service when information from a biosensor falls outside predetermined limits. Thus, the processing machine is capable of determining when to send an instruction to a health care provider, without intervention from the user, in times of what could be critical need, subject to the actual predetermined limits. Thus, the feature of claim 6 --now part of amended claim 1-- allows for this independent act.

The Examiner cites the combination of Goldenberg and Causey as rendering obvious claim 6 and, in particular, cites various portions from Goldenberg in support of the rejection. In particular, the Examiner cites Figures 1, 2 and 8, each of which show a connection across the network for the system disclosed by Goldenberg.

These figures do not, however, identify a condition where a processing machine assesses whether information from a biosensor falls outside a predetermined limit. Accordingly, these mere diagrams do not show a facility to undertake this independent act as recited in amended claim 1.

Paragraphs [0033] and [0035] of Goldenberg describe the transmittal of information to a health care provider. However, the transmittal of information is as a direct result of the user making a decision to transmit said information. For example:

“If not, the problem is referred, after approval by the client, to a medical expert in the subject...” [0033] (*emphasis added*)

“Publication would allow the client to make choices ...” [0035] (*emphasis added*)

In both instances it is the “client” who makes the decision to contact the appropriate health care provider based on his own desire for information from said provider. It is not the processing

machine assessing whether the information should be transmitted to the provider based on certain criteria independent of the user.

With reference to Goldenberg paragraphs [0062] to [0064], also cited by the Examiner in rejecting claim 6, these paragraphs identify the transmittal of information to the health care provider and subsequent action by the health care provider based on this information. However, nowhere is it stated that this information is transmitted as a result of meeting certain criteria other than a desire by the patient/user/client to send said data as a result of his own desire to gain advice from the health care provider. Accordingly, there is no independent act performed by the processing machine to send the appropriate instructions to the health care provider.

In each case cited by paragraphs [0062] to [0064], the focus is on the activity of the health care provider based on receiving the information. Accordingly, these paragraphs do not disclose or suggest the actions of the processing machine to transmit said information.

In view of the foregoing, it is clear that even if there were a reason to combine the Goldenberg and Causey references, Goldenberg fails to provide the claim limitations attributed to it in the office action. As noted in MPEP § 2143.03: "*To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).*

In the case at hand, therefore, the shortcomings of Goldenberg show that a proper *prima facie* case of obviousness has not been made, and the rejection of claim 1 and the claims depending therefrom should be withdrawn.

Claim 37

Independent claim 37 has been amended to include the limitations of now cancelled claim 42. As a result, claim 37 essentially provides the method claim analogy to what is recited in amended claim 1. Thus, for the reasons set forth above, claim 37 and all of its dependent claims are patentable.

Conclusion

In view of the foregoing, applicant submits that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, he is invited to contact applicant's attorney at the telephone number given below.

Respectfully submitted: Hancock Hughey LLP
/pwh #31,169/ Patrick W. Hughey
Registration No. 31,169
Tel. No. (503) 274-5455